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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/996,892      | 11/30/2001  | Hideo Miyake         | 003510-115          | 2777             |

7590 08/20/2003

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| EXAMINER |
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CHU, JOHN S Y

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

1752

DATE MAILED: 08/20/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/996,892

Applicant(s)

MIYAKE ET AL.

Examiner

John S. Chu

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 12-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8 and 10 is/are rejected.
- 7) ☒ Claim(s) 5-7 and 9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

This Office action is in response to the election received May 22, 2003.

1. Applicant's election with traverse of the invention elected in Paper No. 7 is acknowledged. The traversal is on the ground(s) that each of the claims are generic and all the claims read on the elected species, because claim 11 fails to exclude the organic quaternary ammonium salt. This is not found persuasive because claim 11 is drawn to a two layer printing plate precursor wherein both layers are photosensitive and claim 1 is drawn to a single layer printing plate precursor. Each claim may contain the same organic ammonium salt, however claim 11 fails to explicitly recite and claim the compound. Claim 1 and 11 can support separate patents based on the difference in layers used, in essence there are two species of printing plate precursors being restricted.

The requirement is still deemed proper and is therefore made FINAL.

#### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 8, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over GUZZI in view of KAWAMURA et al.

The claimed invention is drawn to a positive printing plate precursor comprising a support having disposed thereon a positive recording layer containing (A) a water-insoluble and alkali-soluble resin, (B) an infrared absorbent and (C) an organic quaternary ammonium salt,

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wherein solubility of the recording layer in an aqueous alkali solution is increased by exposure to an infrared laser.

GUZZI et al discloses a photosensitive negative working printing plate precursor comprising an o-quinonediazide compound and at least one quaternary ammonium compound, see the abstract and column 3, line 37 – column 4, line 22. Applicants are directed to column 4, lines 3-14 for the disclosure of an additive which can include dyes or pigments to render the image visible.

GUZZI et al lacks an explicit disclosure for an infrared absorbent in an example.

KAWAMURA et al is cited to disclose a photosensitive composition comprising a quinonediazide compound and an infrared absorbing compound, see column 32, line 62 – column 35, line 16 for the use of cyanine dyes and infrared absorbing pigments.

KAWAMURA et al lacks a quaternary ammonium salt compound in the composition.

It would have been *prima facie* obvious to one of ordinary skill in the art of photosensitive compositions having a quinonediazide compound to use a cyanine dye or carbon black pigment as a sensitizer in GUZZI et al to provide a visible image and reasonably expect same or similar results with respect to the formation of both a positive or negative image from the exposure.

4. Claims 5-7, and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

None of the references of record disclose the specific quaternary ammonium salt recited.

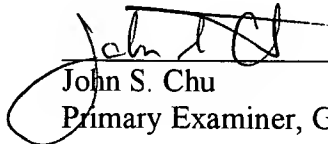
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5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. TORIUMI et al and PRZYBILLA et al are cited of interest to show the state of the art in positive working photosensitive composition having a quinonediazide compound and an organic ammonium salt.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Chu whose telephone number is (703) 308-2298. The examiner can normally be reached on Monday - Friday from 9:30 am to 6:00 pm.

The fax phone number for this Group is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

  
John S. Chu  
Primary Examiner, Group 1700

J.Chu  
August 11, 2003